

REMARKS/ARGUMENTS

Claims 14-19 remain in the application, all of which stand rejected. Claims 1-13 have been canceled.

1. Rejection of Claim 14 Under 35 USC 112

Claim 14 stands rejected under 35 USC 112, second paragraph, as being indefinite. More specifically, the Examiner asserts that the preamble of the claim refers to a system, but the body of the claim includes logic performing a step.

Claim 14 recites a "system" comprising a "tester" and "logic". Applicant believes it is clear that both the "tester" and the "logic" are limitations on the "system" (and are not method steps).

Although claim 14 places certain functional limitations on the recited "logic" (that is, the logic enables one or more resources of the tester according to one or more properties of an electronic license, and the logic creates at least one log file having resource use information for one or more tests executed on the tester), applicant asserts that the functional limitations are not "steps" which make the "system" of claim 14 indefinite. MEP 2173.05(g) states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

For the above reasons, applicant asks that the rejection of claim 14 under 35 USC 112 be withdrawn.

2. Rejection of Claim 1 Under 35 USC 101

Claim 1 stands rejected under 35 USC 101 as being directed to non-statutory subject matter. More specifically, the Examiner asserts that 1) the claim overlaps two statutory classes (i.e., a tester, and logic executing a process), and 2) "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See, the Examiner's 9/19/2007 Office Action, p. 3, sec. 7, citing Ex parte Lyell (17 USPQ2d 1548).

Given that claim 1 was not elected for prosecution, applicant believes the Examiner intended to reject claim 14 under 35 USC 101 (and not claim 1). The Examiner's rejection of claim 1 will therefore be addressed as if it were a rejection of claim 14.

Applicant disagrees with the Examiner's interpretation and application of Lyell's holding. Lyell held that a claim directed to an automatic transmission workstand and the method of using it was ambiguous and properly rejected under 35 USC 112, second paragraph. However, applicant's claim 14 is not directed to a "system" and a method of using the system. Rather, claim 14 is directed to a "system" comprising "logic", with the logic having certain functional limitations.

MEP 2173.05(g) states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

For the above reason, applicant asserts that the functional limitations on the "logic" recited in claim 14 are proper, and that the rejection of claim 14 under 35 USC 101 should be withdrawn.

Furthermore, and should the Examiner persist in asserting that claim 14 spans two statutory classes of invention, applicant notes that MPEP 2173.05(p), in addition to citing Lyell, states:

There are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention.

For the above reasons, applicant asks that the rejection of claim 14 under 35 USC 101 be withdrawn.

3. Rejection of Claims 14-19 Under 35 USC 102(e)

Claims 14-19 stand rejected under 35 USC 102(e) as being anticipated by Organ et al. (US Pat. No. 7,191,368; hereinafter "Organ").

With respect to claim 14, the Examiner asserts that:

...Organ discloses a tester to apply to one or more testers to a device (see abstract - an electronic tester; a test head is coupled to a device under test), logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license (i.e. rule) (see col. 12, lines 4-6) and to create at least one log file having resources use information for one or more tests executed on the tester (see col. 14, lines 46-50).

Applicant respectfully disagrees. Organ's col. 12, lines 4-6, recites:

When a program is loaded, the information is resolved into specific attributes of the selected tester. Tester resource allocation and **rules** checking is performed at this time.

(Emphasis added)

The above is Organ's only mention of "rules". Applicant asserts that nothing in the above excerpt mentions or implies that "rules checking" includes license checking. Nor does the above excerpt mention or imply that Organ utilizes an "electronic license" to enable one or more resources of a tester. Further, it is noted

that Organ's disclosure does not mention a "license" or "licensing" even once. As a result, applicant asserts that Organ is devoid of any teaching or suggestion of "logic. . .to enable one or more resources of [a] tester according to one or more properties of an electronic license". Claim 14 is believed to be allowable for at least this reason.

The Examiner also rejects claim 14 on the basis that Organ, in col. 14, lines 46-50, discloses "logic. . .to create at least one log file having resource use information for one or more tests executed on [a] tester". Organ's col. 14, lines 46-50, recites:

. . .Button number 228 of operator tool 160 allows the user to turn on or turn off the enVision++ data log. When the envision data log is turned on, the measurements made during digital testing of DUT 50 are written to a file.

Area 239 of operator tool 160 is used to display status.

Applicant asserts that nothing in the above excerpt teaches the creation of a log file having "resource use information". That is, the enVision++ **data log** is only a "data log", or a log of "measurements made during digital testing". Organ does not indicate or suggest that the enVision++ log should additionally or alternately be used to log "**resource use information**", as recited in applicant's claim 14. Claim 14 is therefore believed to be allowable for this additional reason.

Claims 15-19 are believed to be allowable, at least, because they depend from claim 14.

4. New Claims 20-25

New claims 20-25 are presented.

Support for claim 20 is found, at least, in paragraph [0017]. Claim 20 is believed to be allowable, at least, because the art of record does not teach creating "at least one log file having resource use information for one or more tests executed on the device tester using the electronic license".

Support for claim 21 is found, at least, in paragraph [0017]. Claim 21 is believed to be allowable, at least, because the art of record does not teach creating

at least one log file having “resource use information” that comprises “information on an amount of time the tester is used”.

Support for claim 22 is found, at least, in paragraph [0017]. Claim 22 is believed to be allowable, at least, because the art of record does not teach creating at least one log file having “resource use information” that comprises “information on an amount of memory used by the tester during testing of the device”.

Support for claim 23 is found, at least, in paragraph [0017]. Claim 23 is believed to be allowable, at least, because the art of record does not teach creating at least one log file having “resource use information” that comprise “a maximum amount of memory used by the tester over a predefined period of time”.

Support for claim 24 is found, at least, in paragraph [0017]. Claim 24 is believed to be allowable, at least, because the art of record does not teach creating at least one log file having “resource use information” that comprises “information on a speed at which tests are executed by the tester”.

Support for claim 25 is found, at least, in paragraph [0019]. Claim 25 is believed to be allowable, at least, because the art of record does not teach “logic” for generating “a usage report based on the at least one log file”.

5. Conclusion

In light of the amendments and remarks provided herein, applicant respectfully requests the issuance of a Notice of Allowance.

Respectfully submitted,
HOLLAND & HART, LLP

By:


Gregory W. Osterloft
Reg. No. 36,232
Tel: (303) 295-8205